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EXAMINER

WASSUM, LUKE S

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,571

Applicant(s)

DANIELS ET AL.

Examiner

Luke S. Wassum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005 and 25 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 13 March 2005, has been received, entered into the record, and considered.
2. The amendment consists of an affidavit under 37 C.F.R. § 1.131. There have been no amendments to the claims. Claims 1-13 remain pending in the application.

The Invention

3. The claimed invention is a supply chain management system for managing the production, sales and distribution of petroleum lubricants.

Status of Rejection

4. In the examiner's previous Office action, mailed 14 January 2005, new grounds of rejection (in addition to grounds of rejection previously set forth in the Office action mailed 17 February 2004) were introduced. In spite of this fact, the examiner erroneously made the rejection Final.
5. In light of these facts, the examiner withdraws the finality of the previous rejection. The rejection mailed on 14 January 2005 will be treated as non-final. The rejection maintained in this Office action is a Final rejection.

Affidavit under 37 C.F.R. 1.131

6. The affidavit filed on 13 May 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the **Navani et al.** and **Dabbiere et al.** references (U.S. Patent Application Publications 2002/0049667 and 2002/0013721, respectively).

7. From MPEP 715.04[R-2]:

An affidavit is a statement in writing made under oath before a notary public, magistrate, or officer authorized to administer oaths. See MPEP § 604 through § 604.06 for additional information regarding formal requirements of affidavits. 37 CFR 1.68 permits a declaration to be used instead of an affidavit. The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true.

8. From MPEP 602 (II):

U.S. Patent and Trademark Office personnel are authorized to accept a statutory declaration under 28 U.S.C. 1746 filed in the U.S. Patent and Trademark Office in lieu of an "oath" or declaration under 35 U.S.C. 25 and 37 CFR 1.68, provided that the statutory declaration otherwise complies with the requirements of law. Section 1746 of Title 28 of the United States Code provides:

Whenever, under any law of the United States or under any rule, regulation, order, or requirement made pursuant to law, any matter is required to be supported, evidenced, established, or proved by sworn declaration, verification, certificate, statement, oath or affidavit, in writing of the person making the same (other than a deposition, or an oath of office, or an oath required to be taken before a specified official other than notary public), such matter may, with like force and effect, be supported, evidenced, established, or proved by the unsworn declaration, certificate, verification, or statement, in writing

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of such person which is subscribed by him, as true under penalty of perjury, and dated, in substantially the following form:

[1] If executed without the United States:

"I declare (or certify, verify, or state) under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on (date).

(Signature)."

[2] If executed within the United States its territories, possessions, or commonwealths:

"I declare (or certify, verify, or state) under penalty of perjury that the foregoing is true and correct. Executed on (date).

(Signature)."

9. It appears on its face that the affidavits submitted by the Applicants contain several informalities, such as the lack of statutory language set out by 18 U.S.C. § 1001. However, in order to advance prosecution of the application, the affidavit and exhibits will be considered by the examiner.

10. MPEP §715.07 (I) states, *inter alia*,

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad

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terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

11. In the case of the instant affidavits, they appear to amount essentially to mere pleading, unsupported by proof or a showing of facts, as described above. They fail to clearly set out specific facts which demonstrate that the claimed invention was conceived and diligently reduced to practice before the date of the applied references, and therefore also fail to clearly explain which exhibits are relied upon as evidence to support which specific facts.

As such, the Applicants have failed to meet their burden under 37 C.F.R. § 1.131(b).

12. Nevertheless, in order to expedite the prosecution of the application, the examiner has reviewed and considered the affidavits and accompanying exhibits, in light of the provisions of 37 C.F.R. § 1.131.

13. From MPEP § 715.07 (III):

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (MPEP § 715.07(c)), at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction

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to practice, 37 CFR 1.131). As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

(A) reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

14. From MPEP §2138.04[R-1]:

Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." *Townsend v Smith*, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." *Gunter v Stream*, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). See also *Coleman v Dins*, 754 F.2d 353, 224 USPQ 857 (Fed. Cir. 1985) (It is settled that in establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception. Conception must be proved by corroborating evidence.)

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15. In the case of the instant affidavits and supporting exhibits, the Applicants have failed to meet their burden to supply facts and supporting evidence that the claimed invention, including at least all of the features of the independent claims, was conceived prior to the dates of the applied references. As stated above, conception is more than a mere vague idea of how to solve a problem. The various status reports submitted as exhibits merely demonstrate that the Applicants intended to implement some Internet-based lubricant supply chain system.

16. Even assuming, arguendo, that conception had been established, there is no showing of diligence supported by the exhibits.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

What is meant by diligence is brought out in *Christie v Seybold*, 1893 C.D. 515, 64 O.G. 1650 (6th Cir. 1893). In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). Diligence must be judged on the basis of the particular facts in each case. See MPEP § 2138.06 for a detailed discussion of the diligence requirement for proving prior invention.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or

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declaration under 37 CFR 1.131. See *Ex parte Merz*, 75 USPQ 296 (Bd. App. 1947).

17. The exhibits provided in support of the Applicants' affidavit are a business plan, meeting notes and status reports, all undated. The Applicants have failed to meet their burden of providing explicit facts and supporting evidence which would demonstrate diligence in reducing the invention to practice over the critical period, which in this case begins 22 May 2000 and ends on the date the instant patent application was filed.

18. Regarding reduction to practice, MPEP §715.07 states:

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

19. From MPEP §2138.05:

Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the claimed invention is filed. The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application. *Hyatt v Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998).

When a party to an interference seeks the benefit of an earlier-filed U.S. patent application, the earlier application must meet the requirements of 35 U.S.C. 120 and 35 U.S.C. 112, first paragraph for the subject matter of the count. The earlier application must meet the enablement requirement and must contain a written description of the subject matter of the interference count. *Hyatt v Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). Proof of a constructive reduction to practice requires sufficient disclosure under the "how to use" and "how to make"

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requirements of 35 U.S.C. 112, first paragraph. *Karuni v Metlesics*, 480 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973) (A constructive reduction to practice is not proven unless the specification discloses a practical utility where one would not be obvious. Prior art which disclosed an anticonvulsant compound which differed from the claimed compound only in the absence of a -CH₂- group connecting two functional groups was not sufficient to establish utility of the claimed compound because the compounds were not so closely related that they could be presumed to have the same utility.). The purpose of the written description requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). The written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed. Furthermore, the written description must be sufficient, when the entire specification is considered, such that the "necessary and only reasonable construction" that would be given it by a person skilled in the art is one that clearly supports each positive limitation in the count. *Hyatt v Boone*, 146 F.3d at 1354-55, 47 USPQ2d at 1130-1132 (Fed. Cir. 1998) (The claim could be read as describing subject matter other than that of the count and thus did not establish that the applicant was in possession of the invention of the count.). See also *Bigham v Godtfredsen*, 857 F.2d 1415, 1417, 8 USPQ2d 1266, 1268 (Fed. Cir. 1988) ("[t]he generic term halogen comprehends a limited number of species, and ordinarily constitutes a sufficient written description of the common halogen species, except where the halogen species are patentably distinct).

"The nature of testing which is required to establish a reduction to practice depends on the particular facts of each case, especially the nature of the invention." *Gellert v Wanberg*, 495 F.2d 779, 783, 181 USPQ 648, 652 (CCPA 1974) ("an invention may be tested sufficiently ... where less than all of the conditions of actual use are duplicated by the tests"); *Wells v Fremont*, 177 USPQ 22, 24-5 (Bd. Pat. Inter. 1972) ("even where tests are conducted under bench' or laboratory conditions, those conditions must fully duplicate each and every condition of actual use' or if they do not, then the evidence must establish a relationship between the subject matter, the test condition and the intended functional setting of the invention," but it is not required that all the conditions of all actual uses be duplicated, such as rain, snow, mud, dust and submersion in water).

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20. In this case, there are no facts asserted by the Applicants and no evidence that the claimed invention was reduced to practice prior to the date of the instant patent application, 16 August 2001.

21. The affidavit filed by the Applicants under 37 C.F.R. § 1.131 fails to establish that the claimed invention was reduced to practice prior to the critical period, and also fails to establish that the claimed invention was conceived prior to the critical period and diligently reduced to practice thereafter. As such, the affidavit is insufficient to establish invention prior to the prior art references relied upon in the rejections of record. The rejections are maintained by the examiner.

Drawings

22. New formal drawings submitted by the Applicants are acknowledged and approved.

Claim Rejections - 35 USC § 102

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

24. Claims 1-3, 5-8, 10, 11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Navani et al. (U.S. Patent Application Publication 2002/0049667).

25. Regarding claim 1, **Navani et al.** teaches a computer programmed to execute a process for lubricants supply chain management as claimed, said process comprising:

- a) upon receiving a request from a web-browser client, querying a database comprising a catalog of lubricants and prices and availability for same and serving said results of said query to said requesting web-browser client for display (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also disclosure of the use of a search engine, paragraphs [0175] and [0176]; see also description of pricing information, paragraph [0064]);
- b) serving an order form to said web-browser client which is configured to contain fields for order quantity and type for lubricants, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also the information associated with each posted trade deal, paragraphs [0044] through [0056]);
- c) receiving an order from said web-browser client for a specific type and quantity of lubricants and having a specific delivery type selected (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also the information associated with each posted trade deal, paragraphs [0044] through [0056]);
- d) electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Lubricant Blender or an Order Fulfillment Agent, and mixtures thereof (see disclosure that trade details are transmitted to collaborative workflow applications, scheduling application, etc., paragraph [0096] and [0110]; see

also disclosure that decision support tools are used to help end users quickly evaluate petroleum products for supply, blending and trading purposes, and also includes transport scheduling tools, paragraphs [0117] and [0118]);

- e) electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent (see disclosure of the notification of the vessel broker/owner to secure/reserve the vessel, paragraph [0110]);
- f) wherein said Freight-Handling Agent inputs information into a delivery optimization system which outputs a delivery schedule which includes said order, and electronically transmits over a network said order and said delivery information to at least one Trucking Company (see details of the transport selection and optimization tools, paragraphs [0180] through [0184]; see also disclosure that 'vessel' may be any transportation container used to carry cargo, including a truck, paragraph [0206]); and
- g) maintaining the status and all actions and communications for said order in a web-accessible database (see disclosure of the Collaborative Workflow Environment, through which users can see the details and status of any Collaborative Workflow Processes, paragraphs [0200] through [0203]).

26. Regarding claim 6, **Navani et al.** teaches a computer readable medium having a computer readable program means embodied thereon for lubricants supply chain management as claimed, said computer readable program means comprising:

- a) computer readable program code means for receiving a request from a web-browser client, querying a database comprising a catalog of lubricants and prices and availability for same and serving said results of said query to said requesting web-

browser client for display (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also disclosure of the use of a search engine, paragraphs [0175] and [0176]; see also description of pricing information, paragraph [0064]);

- b) computer readable program code means for serving an order form to said web-browser client which is configured to contain fields for order quantity and type for lubricants, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also the information associated with each posted trade deal, paragraphs [0044] through [0056]);
- c) computer readable program code means for receiving an order from said web-browser client for a specific type and quantity of lubricants and having a specific delivery type selected (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also the information associated with each posted trade deal, paragraphs [0044] through [0056]);
- d) computer readable program code means for electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Lubricant Blender or an Order Fulfillment Agent, and mixtures thereof (see disclosure that trade details are transmitted to collaborative workflow applications, scheduling application, etc., paragraph [0096] and [0110]; see also disclosure that decision support tools are used to help end users quickly evaluate petroleum products for supply, blending and

trading purposes, and also includes transport scheduling tools, paragraphs [0117] and [0118]);

e) computer readable program code means for electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent (see disclosure of the notification of the vessel broker/owner to secure/reserve the vessel, paragraph [0110]); and

f) computer readable program code means for maintaining the status and all actions and communications for said order in a web-accessible database (see disclosure of the Collaborative Workflow Environment, through which users can see the details and status of any Collaborative Workflow Processes, paragraphs [0200] through [0203]).

27. Regarding claim 11, **Navani et al.** teaches a method for lubricants supply chain management as claimed, comprising:

- a) storing in a web-accessible database a catalog of lubricants and prices-per-unit and availability for same which prices-per-unit decrease based on certain pre-determined criteria (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also disclosure of the use of a search engine, paragraphs [0175] and [0176]; see also description of pricing information, paragraph [0064], and the fact that quantity discounts may be given, paragraph [0060]);
- b) upon receiving at a web server a request from a web-browser client, querying a database and serving said results of said query to said requesting web-browser client for display (see description of the tab-based interface for selection of desired lubricant, paragraph

- [0043]; see also disclosure of the use of a search engine, paragraphs [0175] and [0176]; see also description of pricing information, paragraph [0064]);
- c) serving an order form to said web-browser client which is configured to contain fields for order quantity and type for lubricants, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also the information associated with each posted trade deal, paragraphs [0044] through [0056]);
- d) receiving an order from said web-browser client for a specific type and quantity of lubricants and having a specific delivery type selected (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also the information associated with each posted trade deal, paragraphs [0044] through [0056]);
- e) electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Lubricant Blender or an Order Fulfillment Agent, and mixtures thereof (see disclosure that trade details are transmitted to collaborative workflow applications, scheduling application, etc., paragraph [0096] and [0110]; see also disclosure that decision support tools are used to help end users quickly evaluate petroleum products for supply, blending and trading purposes, and also includes transport scheduling tools, paragraphs [0117] and [0118]);
- f) wherein said order fulfillment agent electronically transmits over a network said order and blending specifications to at least one lubricant blender (see disclosure that decision support tools are used to help end users quickly evaluate petroleum products for

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- supply, blending and trading purposes, paragraphs [0117] and [0118]; see also extensive disclosure of blending and trading tools, paragraphs [0125] through [0160];
- g) electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent (see disclosure of the notification of the vessel broker/owner to secure/reserve the vessel, paragraph [0110]);
- h) wherein said Freight-Handling Agent inputs information into a delivery optimization system which outputs a delivery schedule which includes said order, and electronically transmits over a network said order and said delivery information to at least one Trucking Company (see details of the transport selection and optimization tools, paragraphs [0180] through [0184]; see also disclosure that 'vessel' may be any transportation container used to carry cargo, including a truck, paragraph [0206]); and
- i) maintaining the status and all actions and communications for said order in a web-accessible database (see disclosure of the Collaborative Workflow Environment, through which users can see the details and status of any Collaborative Workflow Processes, paragraphs [0200] through [0203]).

28. Regarding claims 2 and 7, Navani et al. additionally teaches a computer and computer readable medium wherein said fulfillment agent is an order fulfillment agent and said order fulfillment agent electronically transmits over a network said order to at least one lubricant blender (see disclosure that decision support tools are used to help end users quickly evaluate petroleum products for supply, blending and trading purposes, paragraphs [0117] and [0118]; see also extensive disclosure of blending and trading tools, paragraphs [0125] through [0160]).

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29. Regarding claims 3 and 8, Navani et al. additionally teaches a computer and computer readable medium which further comprises serving a product search page to said web browser client, wherein said search page comprising fields supporting alternate search methods selected from the group consisting of product name, product application, cross-applications and mixtures thereof (see description of the tab-based interface for selection of desired lubricant, paragraph [0043]; see also disclosure of the use of a search engine, paragraphs [0175] and [0176]).

30. Regarding claims 5, 10 and 13, Navani et al. additionally teaches a method, computer and computer readable medium wherein prices decrease based on cumulative purchase volume over a pre-determined time period (see disclosure that quantity discounts may be given, paragraph [0060]).

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

33. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

34. Claims 4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Navani et al.** (U.S. Patent Application Publication 2002/0049667) as applied to claims 1-3, 5-8, 10, 11 and 13 above, and further in view of **Hager et al.** (U.S. Patent 6,085,808).

35. Regarding claims 4, 9 and 12, **Navani et al.** teaches a method, computer and computer readable medium substantially as claimed, including performing lubricant analysis (see discussion of the CBAT-G analysis tool, paragraphs [0132] through [0138].

Navani et al. does not explicitly teach a method, computer and computer readable medium which further comprises receiving an order from said web-browser client for a specific type of service selected from the group of empty drum pickup, lubricant analysis, used lubricant pickup and mixtures thereof, and electronically transmitting over a network said order to a service order fulfillment agent.

Hager et al., however, teaches that the collection of empty drums and contaminated solvent is optimally performed in conjunction with the distribution of fresh solvent (see Abstract; see also col. 1, lines 10-29; see also col. 1, line 55 through col. 2, line 20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the ability to request collection of empty drums and used lubricant and the analysis of lubricants into the supply chain management system of **Navani et al.**, because these services are routinely required in the petroleum distribution business, and is normally performed in conjunction with the distribution of said lubricants; coordinating such services with the purchase and distribution of new lubricants would improve the efficiency with which such services could be carried out.

36. Claims 1, 2, 6, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbiere et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution").

37. Regarding claim 1, **Dabbiere et al.** teaches a computer programmed to execute a process for supply chain management substantially as claimed, said process comprising:

- a) upon receiving a request from a web-browser client, querying a database comprising a catalog of products and prices and availability for same and serving said results of said

- query to said requesting web-browser client for display (see discussion of access to browser-based item catalog, paragraphs [0028] and [0030]);
- b) serving an order form to said web-browser client which is configured to contain fields for order quantity and type for products, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote (see disclosure of submission of an order, including specifying delivery information, paragraph [0044]; see also the capability to access price information, paragraph [0030]);
 - c) receiving an order from said web-browser client for a specific type and quantity of products and having a specific delivery type selected (see paragraph [0045]);
 - d) electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Manufacturer or an Order Fulfillment Agent, and mixtures thereof (see disclosure that purchase orders are routed to the manufacturing facility and the sales manager, paragraphs [0056] through [0059]);
 - e) electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent (see disclosure that the system includes a delivery or transportation location, paragraphs [0031] and [0032]);
 - f) wherein said Freight-Handling Agent electronically transmits over a network said order and said delivery information to at least one Trucking Company (see disclosure that the system includes a delivery or transportation location, paragraphs [0031] and [0032]); and
 - g) maintaining the status and all actions and communications for said order in a web-accessible database (see paragraphs [0030] and [0063] through [0066], et seq.).

Dabbieri et al. does not explicitly teach a computer programmed to execute a process for supply chain management wherein the product is a lubricant, nor including the use of a delivery optimization system to optimize a delivery schedule.

Business Wire, however, teaches a computer programmed to execute a process for supply chain management wherein the product is a lubricant, nor including the use of a delivery optimization system to optimize a delivery schedule (see disclosure of the Transportation Scheduling Optimizer, page 2, middle).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply supply chain management to the petroleum industry and include a delivery optimization system, since both improvements would serve to improve the efficiency with which petroleum companies distribute their products from the refineries to customers.

38. Regarding claim 6, **Dabbieri et al.** teaches a computer readable medium having a computer readable program means embodied thereon for supply chain management substantially as claimed, said computer readable program means comprising:

- a) computer readable program code means for receiving a request from a web-browser client, querying a database comprising a catalog of products and prices and availability for same and serving said results of said query to said requesting web-browser client

for display (see discussion of access to browser-based item catalog, paragraphs [0028] and [0030]);

- b) computer readable program code means for serving an order form to said web-browser client which is configured to contain fields for order quantity and type for lubricants, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote (see disclosure of submission of an order, including specifying delivery information, paragraph [0044]; see also the capability to access price information, paragraph [0030]);
- c) computer readable program code means for receiving an order from said web-browser client for a specific type and quantity of products and having a specific delivery type selected (see paragraph [0045]);
- d) computer readable program code means for electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Manufacturer or an Order Fulfillment Agent, and mixtures thereof (see disclosure that purchase orders are routed to the manufacturing facility and the sales manager, paragraphs [0056] through [0059]);
- e) computer readable program code means for electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent (see disclosure that the system includes a delivery or transportation location, paragraphs [0031] and [0032]); and

f) computer readable program code means for maintaining the status and all actions and communications for said order in a web-accessible database (see paragraphs [0030] and [0063] through [0066], et seq.).

Dabbieri et al. does not explicitly teach a computer programmed to execute a process for supply chain management wherein the product is a lubricant, nor including the use of a delivery optimization system to optimize a delivery schedule.

Business Wire, however, teaches a computer programmed to execute a process for supply chain management wherein the product is a lubricant, nor including the use of a delivery optimization system to optimize a delivery schedule (see disclosure of the Transportation Scheduling Optimizer, page 2, middle).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply supply chain management to the petroleum industry and include a delivery optimization system, since both improvements would serve to improve the efficiency with which petroleum companies distribute their products from the refineries to customers.

39. Regarding claim 11, **Dabbieri et al.** teaches a method for supply chain management substantially as claimed, comprising:

a) storing in a web-accessible database a catalog of products and prices-per-unit and availability for same which prices-per-unit decrease based on certain pre-determined

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- criteria (see discussion of access to browser-based item catalog, including price information, paragraphs [0028] and [0030]);
- b) upon receiving at a web server a request from a web-browser client, querying a database and serving said results of said query to said requesting web-browser client for display (see discussion of access to browser-based item catalog, paragraphs [0028] and [0030]);
- c) serving an order form to said web-browser client which is configured to contain fields for order quantity and type for lubricants, delivery type preferences and delivery address entered in said web-browser client, and determining and displaying on said web-browser client a delivery price quote (see disclosure of submission of an order, including specifying delivery information, paragraph [0044]; see also the capability to access price information, paragraph [0030]);
- d) receiving an order from said web-browser client for a specific type and quantity of products and having a specific delivery type selected (see paragraph [0045]);
- e) electronically transmitting over a network said order to a fulfillment agent selected from the group consisting of a Manufacturer or an Order Fulfillment Agent, and mixtures thereof (see disclosure that purchase orders are routed to the manufacturing facility and the sales manager, paragraphs [0056] through [0059]);
- f) wherein said order fulfillment agent electronically transmits over a network said order and product specifications to at least one manufacturer (see disclosure that a specific size breakdown is transmitted as part of the order, paragraph [0044];

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- g) electronically transmitting over a network said order and said delivery information to a Freight-Handling Agent (see disclosure that the system includes a delivery or transportation location, paragraphs [0031] and [0032]);
- h) wherein said Freight-Handling Agent electronically transmits over a network said order and said delivery information to at least one Trucking Company (see disclosure that the system includes a delivery or transportation location, paragraphs [0031] and [0032]); and
- i) maintaining the status and all actions and communications for said order in a web-accessible database (see paragraphs [0030] and [0063] through [0066], et seq.).

Dabbieri et al. does not explicitly teach a computer programmed to execute a process for supply chain management wherein the product is a lubricant, nor including the use of a delivery optimization system to optimize a delivery schedule.

Business Wire, however, teaches a computer programmed to execute a process for supply chain management wherein the product is a lubricant, nor including the use of a delivery optimization system to optimize a delivery schedule (see disclosure of the Transportation Scheduling Optimizer, page 2, middle).

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply supply chain management to the petroleum industry and include a delivery optimization system, since both improvements would serve to improve the efficiency with which petroleum companies distribute their products from the refineries to customers.

40. Regarding claims 2 and 7, **Dabbieri et al.** additionally teaches a computer and computer readable medium wherein said fulfillment agent is an order fulfillment agent and said order fulfillment agent electronically transmits over a network said order to at least one manufacturer (see disclosure of the sales manager changing a manufacturing order, paragraph [0053] and [0054], the manufacturer being analogous to the claimed lubricant blender).

41. Claims 4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") as applied to claims 1, 2, 6, 7 and 11 above, and further in view of **Hager et al.** (U.S. Patent 6,085,808).

42. Regarding claims 4, 9 and 12, **Dabbieri et al.** and **Business Wire** teach a method, computer and computer readable medium substantially as claimed.

Neither **Dabbieri et al.** nor **Business Wire** explicitly teaches a method, computer and computer readable medium which further comprises receiving an order from said web-browser client for a specific type of service selected from the group of empty drum pickup, lubricant analysis, used lubricant pickup and mixtures thereof, and electronically transmitting over a network said order to a service order fulfillment agent.

Hager et al., however, teaches that the collection of empty drums and contaminated solvent is optimally performed in conjunction with the distribution of fresh solvent (see Abstract; see also col. 1, lines 10-29; see also col. 1, line 55 through col. 2, line 20).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the ability to request collection of empty drums and used lubricant and the analysis of lubricants into the supply chain management system of **Dabbieri et al.** and **Business Wire**, because these services are routinely required in the petroleum distribution business, and is normally performed in conjunction with the distribution of said lubricants; coordinating such services with the purchase and distribution of new lubricants would improve the efficiency with which such services could be carried out.

43. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") as applied to claims 1, 2, 6, 7 and 11 above, and further in view of **Peterson et al.** (U.S. Patent Application Publication 2001/0011232).

44. Regarding claims 3 and 8, **Dabbieri et al.** and **Business Wire** teach a computer and computer readable medium substantially as claimed.

Neither **Dabbieri et al.** nor **Business Wire** explicitly teaches a computer and computer readable medium which further comprises serving a product search page to said web browser client, wherein said search page comprising fields supporting alternate search methods selected from the group consisting of product name, product application, cross-applications and mixtures thereof.

Peterson et al., however, teaches a computer and computer readable medium which further comprises serving a product search page to said web browser client, wherein said search page comprising fields supporting alternate search methods selected from the group consisting of product name, product application, cross-applications and mixtures thereof (see description of various search criteria available to the user, paragraphs [0063] through [0069]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow a user to search a catalog based on different search criteria, since this would allow efficient and versatile methods for the user to locate desired products.

45. Claims 5, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") as applied to claims 1, 2, 6, 7 and 11 above, and further in view of **Phillips et al.** (U.S. Patent Application Publication 2002/0116348).

46. Regarding claims 5, 10 and 13, **Dabbieri et al.** and **Business Wire** teach a method, computer and computer readable medium substantially as claimed.

Neither **Dabbiere et al.** nor **Business Wire** explicitly teaches a method, computer and computer readable medium which further comprises serving a product search page to said web browser client, wherein prices decrease based on cumulative purchase volume over a pre-determined time period.

Phillips et al., however, teaches a method, computer and computer readable medium wherein prices decrease based on cumulative purchase volume over a pre-determined time period (see disclosure that quantity discounts may be given, paragraph [0046]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to institute volume discounts, since businesses value customers that make high volume purchases, and it is worthwhile to encourage such bulk purchases through the use of volume discounts.

Response to Arguments

47. Applicant's arguments filed 17 August 2004 have been fully considered but they are not persuasive.

48. Regarding the affidavit filed under 37 C.F.R. § 1.131, this affidavit is not effective to disqualify the prior art of record, for the reasons stated above.

Conclusion

49. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Luke S. Wassum
Primary Examiner
Art Unit 2167